REMARKS

This is a full and timely response to the outstanding final Office Action mailed April 21, 2006. Reconsideration and allowance of the application and presently pending claims 1-2, 7-17, 21-22, 25-37, 39-43, 48-49, 51-59, and 63 are respectfully requested.

Response to Objection of Claims

Claim 57 has been objected to for being a substantial duplicate of claim 63. Accordingly, claim 63 has been amended to depend from a different base claim than that which is referenced in claim 57. Accordingly, the objection should be withdrawn.

2. Response to Rejection of Claims under 35 U.S.C. §103

In the Office Action, claims 54-56 and 58-59 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable by *Chan* (U.S. Patent No. 6,378,070) in view of *Toyoda* (U.S. Patent No. 6,335,966). Claims 54-56 and 58 have also been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable by *Mandelbaum* (EP Application Publication No. 0671830 A2) in view of *Toyoda*. In the Office Action, claims 1-2, 8-10, 13-17, 22-24, 41-43, and 48-49, and 51-53 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Chan* in view of *Nishiwaki*. Claims 1-2, 5-11, 13-17, 41-43, 46-48, 54-56, and 58 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Mandelbaum* in view of *Nishiwaki*. Claim 7 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Chan* in view of *Nishiwaki* in further view of *Menezes* (Handbook of Applied Cryptography). Claims 11-12 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Chan* in view of *Nishiwaki* in further view of *Schneier* (Applied Cryptography). Claim 12 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Mandelbaum* in view of *Nishiwaki* in further view of *Schneier*. Claims 21, 25-37, and 39-40 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Chan* in view of *Carman* (U.S. Patent No. 6,272,632). Claims 21-22, 25-37, and 39 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Mandelbaum* in view of *Schneier* in further view of *Carman*. Claim 39 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Mandelbaum* in view of *Schneier* in further view of *Carman*. Claim 40 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Mandelbaum* in view of *Carman*. Claims 57 and 63 stand rejected under 35 U.S.C. §103(a) as allegedly

being unpatentable over *Chan* in view of *Toyoda* in further view of *Schneier*. Claims 57 and 63 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Mandelbaum* in view of *Toyoda* in further view of *Schneier*. Claim 59 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Mandelbaum* in view of *Toyoda* in further view of *Auerbach* (European Patent Application Publication No. 0798892 A2). For a proper rejection of a claim under 35 U.S.C. Section 103, the cited reference must disclose all elements/features/steps of the claim. *See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 USPQ2d 1129 (Fed. Cir. 1988).

a. Claims 54-59

In the Office Action, it is stated that "Chan fails to disclose that a first station is configured for transmitting a document as a non-encrypted transmission when a second station is not configured for decryption. Toyoda discloses that a first fax station may be configured for transmitting a document as non-encrypted transmission when a second station is not configured for decryption." Pages 3 and 5.

Applicants respectfully point out that claim 54 recites "determining prior to transmission of the document whether the second station is one which is arranged to stop a transmitted document from being released until the intended recipient has proved their identity, wherein the first station is configured to alternatively transmit the document as a non-encrypted transmission when the second station is determined to not be capable of stopping a transmitted document from being released until the intended recipient has proved their identity." (Emphasis added). As such, regardless if *Toyoda* teaches transmitting a document as non-encrypted transmission when a second station is not configured for decryption, *Toyoda* (and therefore the proposed combination of *Chan* in view of *Toyoda* or *Mandelbaum* in view of *Toyoda*) fail to teach or suggest transmitting the document as a non-encrypted transmission when a second station is determined to not be capable of stopping a transmitted document from being released until the intended recipient has proved their identity, as described in claim 54. Therefore, a *prima facie* case of obviousness has not been established with respect to independent claim 54.

Because independent claim 54 is allowable over the cited art of record, dependent claims 55-59 (which depend from independent claim 54) are allowable as a matter of law for at least the reason that these dependent claims contain all features/elements of their

respective independent base claim and none of the cited references cure the deficiencies of the proposed combinations.

Accordingly, the rejection to these dependent claims should be withdrawn.

b. Claims 1-2 and 7-20

In the Office Action, it is stated that the "Examiner submits that the processes can be co-located as indicated by Chan (Col. 8, lines 30-34). Further, even if Applicant's assertion were correct, Examiner fails to see how such an argument precludes claim 1 part a) from being met.

With regard to this point, *Chan* is apparently limited to at most a system wherein "the secure printing process forwards across the network 110, to the document store 130, a message comprising the encrypted document. . . . [T]he document store 130 receives the message and stores it appropriately to hard disk 135." Col. 6, lines 48-54. Therefore, *Chan* fails to teach or suggest the step of "receiving and securely retaining a transmitted document at the printout station," as recited in claim 1, since the document store is not co-located with a printer in *Chan*. (Emphasis added). *Chan* also teaches that a document is forwarded from a print server to a printout station after the recipient identifies himself or herself at the printout station. Accordingly, *Chan* does not teach or suggest that a document is retained at the printout station such that it is released after an intended recipient proves their identity. Therefore, a *prima facie* case of obviousness has not been established.

The Office Action notes that *Chan* states that "components and processes described above need not reside on different computers. For example, the local computer 100 could support directory server and document store processes, as well as secure printer process." Col. 8, lines 31-35. This fails to teach or suggest "receiving and securely retaining a transmitted document at the printout station," however, since local computer 100 is not a printout station. It is clear that *Chan* fails to teach or suggest a printout station receiving and securely retaining a transmitted document. For at least this reason, a *prima facie* case of obviousness has not been established by the proposed combination of *Chan* in view of *Nishiwaki*.

Similarly, *Mandelbaum* is apparently limited to at most a system for controlling the printing of documents at a facsimile apparatus and does not suggest or teach an approach for controlling access to already printed documents. For example, *Mandelbaum* teaches that a

user is to be present at a print unit for the document to be printed. Therefore, *Mandelabum* provides no motivation or suggestion of having a document placed in a locked compartment of a printer unit that is to be accessed by a user, when *Mandelbaum* teaches that the user must be present at the printer unit for the document to be printed in the first place.

The Office Action is in disagreement with the foregoing and states that "motivation still exists for combining Nishiwaki into the system because doing so furthers security by also requiring a user to submit an identification code." Applicants submit that it seems such a modification for requiring a user to enter an identification code after a key from a smart card has already been provided (as taught by *Mandelbaum*) is not a reasonable modification, since these steps seem duplicative and performing one would seem to render the step in the other cited reference "unsatisfactory for its intended purpose." *See* MPEP § 2143.01.

For at least these reasons, the proposed combination of *Mandelbaum* in view of *Nishiwaki* does not establish prima facie cases of obviousness with respect to claim 1.

Because independent claim 1 is allowable over the cited art of record, dependent claims 2 and 7-20 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that these dependent claims contain all features/elements of their respective independent base claim and none of the cited references cure the deficiencies of the proposed combinations.

Accordingly, the rejection to these dependent claims should be withdrawn.

c. Claims 21-37 and 39

Chan is apparently limited to at most a system wherein "the secure printing process forwards across the network 110, to the document store 130, a message comprising the encrypted document. . . . [T]he document store 130 receives the message and stores it appropriately to hard disk 135." Col. 6, lines 48-54. Therefore, *Chan* fails to teach or suggest the step of "receiving and securely retaining the digital document, the encrypted session key and an independently verifiable data record of each intended recipient at a printout station," as recited in claim 21, since the document store is not co-located with a printer in *Chan*. *Chan* also teaches that a document is forwarded from a print server to a printout station after the recipient identifies himself or herself at the printout station. Accordingly, *Chan* does not teach or suggest that a document is retained at the printout station such that it is released after an intended recipient or group of intended recipients proves their identity.

Accordingly, *Chan* fails to teach or suggest "requesting proof of each intended recipient's identity at the printout station using data in the independently verifiable data record of the intended recipient; receiving proof of each intended recipient's identity in the form of a second token uniquely related to the first token; and decrypting the encrypted session key with the second token, decoding the digital document with the decrypted session key, and releasing the document." Likewise, *Carman* describes a variety of encryption techniques, but fails to teach or suggest a printing approach, as claimed, where each intended recipient proves their identity before a document intended for the recipients is allowed to be released at a printout station. Accordingly, the proposed combination of *Chan* in view of *Carman* does not establish a prima facie case of obviousness with respect to claim 21 and claims 22-37 and 39 which depend therefrom.

Similarly, *Mandelbaum* is apparently limited to at most a system for controlling the printing of documents at a facsimile apparatus and does not suggest or teach an approach for controlling access to a document intended for a group of intended recipients by checking proof of identity of the whole group before the document is released. In this respect, *Schneier* and *Carman* are also inadequate in teaching or suggesting these features. For at least these reasons, the proposed combination of *Mandelbaum* in view of *Schneier* in further view of *Carman* does not establish a prima facie case of obviousness with respect to claim 21.

The Office Action states that Applicants' arguments "amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references." Page 20. However, Applicants' foregoing remarks, which were also included in the prior response, expressly states that the cited references fail to teach or suggest "receiving and securely retaining the digital document, the encrypted session key and an independently verifiable data record of each intended recipient at a printout station," as recited in the claim.

Also, the step of "requesting proof of each intended recipient's identity at the printout station using data in the independently verifiable data record of the intended recipient; receiving proof of each intended recipient's identity in the form of a second token uniquely related to the first token; and decrypting the encrypted session key with the second token, decoding the digital document with the decrypted session key, and releasing the document" is not taught or disclosed. Likewise, the claim describes a process where each intended recipient proves their identity before a document intended for the recipients

s allowed to be released at a printout station, and this process is not taught or suggested by the cited art.

These specific examples and explanations point out how the language of the claims patentable distinguish claim 21 from the cited references.

Accordingly, the proposed combination of *Chan* in view of *Carman* and *Mandelbaum* in view of *Schneier* in further view of *Carman* does not establish a prima facie case of obviousness with respect to claim 21.

Because independent claim 21 is allowable over the cited art of record, dependent claims 22-37 and 39 (which depend from independent claim 21) are allowable as a matter of law for at least the reason that these dependent claims contain all features of their respective independent base claim and none of the cited references cure the deficiencies of the proposed combinations.

Accordingly, the rejection to these dependent claims should be withdrawn.

d. Claim 40

As previously mentioned, *Mandelbaum* and *Chan* do not suggest or teach an approach for controlling access to a document intended for a group of intended recipients by checking proof of identity of the whole group before the document is released. In this respect, *Carman* is also inadequate in teaching or suggesting these features. For at least these reasons, the proposed combination of *Mandelbaum* in view of *Carman* and *Chan* in view of *Carman* does not establish prima facie cases of obviousness with respect to claim 40.

e. Claims 41-43 and 48

Applicants respectfully submit that independent claim 41 is allowable for at least the reason that *Chan* does not disclose, teach, or suggest "one or more lockable compartments and the device is arranged to print out the document as received and place it in one of the compartments, wherein the controller is arranged to release the locked compartment containing the document, once the intended recipient has proved their identity," where the "controller [is] for releasing the document when the intended recipient has proved their identity by use of a second token that is uniquely related to the first token," as recited in claim 41.

Chan teaches that a document is forwarded from a print server to a printout station after the recipient identifies himself or herself at the printout station. Accordingly, *Chan* does not teach or suggest that a document is retained at the printout station such that it is released after an intended recipient or group of intended recipients proves their identity.

With regard to *Nishiwaki*, it teaches that a printer unit sends to a host device the identification of a bin where a document is deposited and either provides a personal identification number for the bin or the personal identification number is provided by the sender of the document. Neither of these provides proof of the identity of an intended recipient, as described in the claim. *See* col. 6, lines 23-65. Accordingly, the proposed combination of *Chan* in view of *Nishiwaki* fails to teach or suggest releasing a document when an intended recipient has proved their identity.

Similarly, *Mandelbaum* is apparently limited to at most a system for controlling the printing of documents at a facsimile apparatus and does not suggest or teach an approach for controlling access to already printed documents. For example, *Mandelbaum* teaches that a user is to be present at a print unit for the document to be printed. Therefore, *Mandelabum* provides no motivation for having a user present when the document is being printed and then instead of allowing the user to access the document, having the printed document deposited in a locked compartment at the print unit so that the user must identify himself or herself again. Further, the inadequacies of the *Nishiwaki* reference, as described above, also apply for a proposed combination with *Mandelbaum*.

For at least these reasons, the proposed combinations of *Chan* in view of *Nishiwaki* and *Mandelbaum* in view of *Nishiwaki* do not establish prima facie cases of obviousness with respect to claim 41 and claims 42-43 and 48 which depend therefrom.

f. Claims 49, 51-53, and 63

Applicants respectfully submit that independent claim 41 is allowable for at least the reason that *Chan* does not disclose, teach, or suggest "one or more lockable compartments and the device is arranged to print out the document as received and place it in one of the compartments, wherein the controller is arranged to release the locked compartment containing the document, once the intended recipient has proved their identity," where the "controller [is] for releasing the document when the intended recipient has proved their identity by use of a second token that is uniquely related to the first token," as recited in claim 49.

Chan teaches that a document is forwarded from a print server to a printout station after the recipient identifies himself or herself at the printout station. Accordingly, *Chan* does not teach or suggest that a document is retained at the printout station such that it is released after an intended recipient or group of intended recipients proves their identity.

With regard to *Nishiwaki*, it teaches that a printer unit sends to a host device the identification of a bin where a document is deposited and either provides a personal identification number for the bin or the personal identification number is provided by the sender of the document which does not provide proof of the identity of an intended recipient, as described in the claim. *See* col. 6, lines 23-65. Accordingly, the proposed combination of *Chan* in view of *Nishiwaki* fails to teach or suggest releasing a document when an intended recipient has proved their identity.

Similarly, *Mandelbaum* is apparently limited to at most a system for controlling the printing of documents at a facsimile apparatus and does not suggest or teach an approach for controlling access to already printed documents. For example, *Mandelbaum* teaches that a user is to be present at a print unit for the document to be printed. Therefore, *Mandelabum* provides no motivation for having a user present when the document is being printed and then instead of allowing the user to access the document, having the printed document deposited in a locked compartment at the print unit so that the user must identify himself or herself again. Further, the inadequacies of the *Nishiwaki* reference, as described above, also apply for a proposed combination with *Mandelbaum*.

For at least these reasons, the proposed combinations of *Chan* in view of *Nishiwaki* and *Mandelbaum* in view of *Nishiwaki* do not establish prima facie cases of obviousness with respect to claim 49 and claims 51-53 and 63 which depend therefrom.

CONCLUSION

For at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,

Charles W. Griggers
Reg. No. 47,283